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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,887	06/21/2001	Levi J. Perea JR.	1710391	6120
24240	7590	07/16/2004	EXAMINER	
CHAPMAN AND CUTLER 111 WEST MONROE STREET CHICAGO, IL 60603			TRINH, MINH N	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/886,887	Applicant(s) PEREA ET AL.	
	Examiner Minh Trinh	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
 4a) Of the above claim(s) 12-32 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-11 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/24/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I (claims 1-11) in the reply filed on 4/15/04 is acknowledged. Thus claims 12-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/15/04. A complete reply to this Office action must include cancelation of nonelected claims 12-32 or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following are examples:

It is not clear whether the phrase after "whereby when loaded . . ." (claim 1, lines 7-9) is part of the claimed invention. Also, it is not known what part of the claimed tool is actually being loaded with an associated connector.

"the insulation of the individual wires" lacks proper antecedent basis.

The phrase: "for abutting the palm of the user of the tool" (claims 6, line 2, claim 7, line 2-3, etc.,) is intended use, and do not further limit the claimed tool. Also, "the

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tool" (claim 6, line 2, claim 7, line 3) should be changed to: -- the hand tool --. for clarification purpose.

The scope of claim 11 is not clear because it is not clear whether "a tether" (see claim 11, line 2) is actually a part of the claimed hand tool.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 as best understood is rejected under 35 U.S.C. 102(b) as being anticipated by Fickes (4,349,944).

Fickes discloses a portable lightweight hand tool for applying an insulation-piercing electrical connector to an insulated electrical cable having a plurality of wires, comprising: at least two part frame 12, 14 manufactured of impact resistant material, the first part of said frame 14 having loading die or base plate 32 for receiving and holding the electrical connector therefrom (see Figs. 3-4); and the second part of the frame 12 having a wire insertion end 66 including a plurality of grooves for receiving the wires to be placed into the connector (see Fig. 2) whereby, when loaded with a connector 36 and wires 92, relative movement of the first and second parts of the frame causes the insulation of the individual wires to be pierced and electrically connected to the connector.(see Fig. 4, depicts the wires 92 being connected to the connector).

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However regarding "movement of the first and second parts of the frame cause the insulation of the individual wires to be pierced and electrically connected to the connector" is functional intended use, which does not further limit the tool as claimed. Because the prior art meet every aspect limitations of the tool therefore it is capable of performing the functionally intended use as described above.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-8 and 11 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Fickes (4,349,944).

As applied to claim 1, it argues that Fickes does not teach the pierce type of connector associated with the tool. It would have been an obvious matter of design choice to choose any desired or type of connector since applicant has not disclosed that the particular type of connector as recited in the claims is critical, patentably distinguishing features and it appears that the invention would perform equally well with the type of connector as disclosed by the prior art reference (see reference 38 of Fickes's Figs. 1-4). It is noted that reference 38 of Fickes is broadly readable as "an insulation piercing connector " as claimed by the present invention.

As applied to claims 2 and 3, regarding the grooves on the frame to be color-coded and are to be impact resistant plastic as recited in claims 2-3. It would have been an obvious matter of design choice to have the frame color coded and are to be plastic as described above since applicant has not disclosed that these features are critical, patentably distinguishing features and it appears that the invention would perform equally well with the conventional material as shown in the prior art reference (see Fickes 'Figs. 1-4).

Limitation of claim 8 is met by Fickes (see Fig. 1 shows guide means including references 22, 24).

Regarding the limitations of claims 6-7, the Fickes discloses the frame includes an arcuate surface and a pair of arcuate fingers associated therefrom (see Fig. 2, reference 12 and 62, these features readable on the claimed arcuate palm and fingers of the present invention's claims.

As applied to claim 11, regarding the limitation of claim 11. It would have been an obvious matter of design choice to have an aperture on the frame of the hand tool for connection to a tether since applicant has not disclosed that this feature is critical, patentably distinguishing features and it appears that the invention would perform equally well with the ring shaped 102 as shown in the prior art reference (see Fickes's Figs. 1-4).

Allowable Subject Matter

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5. Claims 4-5, 9 and 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: That the prior art does not teach the limitations of the above claims i.e. where loading die 128 having two upwardly walls 134a and 134b and grooves 142's for accepting tabs 12's of an associated connector 12 and the detent means cam 84 as recited in claims 9-10. These limitations in combination with other limitations are not taught or fairly suggested by the combination prior art references.

Prior Art References

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references are cited for their teaching of hand tool for connecting connector or the like.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Minh Trinh', followed by a horizontal line.

Minh Trinh 7/14/2004
Patent Examiner Group 3729

mt